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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/982,026

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Hiroshi Miyawaki

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03/30/2006

WENDEROTH, LIND & PONACK, L.L.P.

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WASHINGTON, DC 20006-1021

EXAMINER

LEZAK, ARRIENNE M

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,026

Applicant(s)

MIYAWAKI, HIROSHI

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 July 2005 has been entered.
2. Examiner notes that Claims 25 & 37 have been amended, and no claims have been added or cancelled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 28 July 2005 as reiterated herein below, as Examiner finds the new claims obviously substantively similar to the originally presented claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
4. Claims 25 & 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner finds the amended portion of the claim

language, "and being the same data format as the data reproduced by said information terminal" to be indefinite, requiring correction.

5. Specifically, Examiner finds that the phrase does not make sense where placed. Examiner believes Applicant meant to have the amended portion refer to the converted data; however, as written, the amended portion does not refer to the converted data.

6. Additionally, Examiner finds the use of the word "reproduced" to be incorrect, as the claims make no mention of the information terminal reproducing anything. Examiner believes Applicant meant to use the word "requested" instead of "reproduced", as the claims clearly refer to the information terminal "requesting".

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. New Claims 25-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over consideration of US Patent US 6,192,407 B1 to Smith in view of US Patent 6,092,114 to Shaffer.

9. Regarding Claims 25, 28-37 & 40-48, Smith discloses a data distribution system which comprises an information terminal for requesting distribution of information, and an information provider apparatus for providing information to the information terminal, (Abstract & Figs. 1-20), (per pending Claims 25 & 37), comprising:

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- the information terminal automatically transmitting specifications of the information terminal when transmitting an information provision request which requests distribution of information, (Col. 15, lines 8-67 & Col. 16, lines 1-59), (Examiner notes that PURL attributes associated with delivery would obviously include information terminal specifications, in order to secure document delivery, tracking of document receipt and format compatibility - Abstract); and
- the information provider apparatus including:
  - o a receiving unit for receiving the information provision request and the information terminal specifications transmitted from the information terminal, (Col. 15, lines 8-67 & Col. 16, lines 1-59);
  - o a data storage unit for storing and managing various kinds of information data, (Col. 15, lines 8-67 & Col. 16, lines 1-59);
  - o a data detection unit for detecting data corresponding to the information provision request received by the receiving unit from the data storage unit, (Col. 15, lines 8-67 & Col. 16, lines 1-59);
  - o a data conversion unit for converting the data detected by the data detection unit so as to conform to the information terminal specifications received by the receiving unit, and being in the same data format as the data [requested] by said information terminal, (Fig. 5; Col. 5, lines 10-30; & Col. 10, lines 55-60);

- and a transmission unit for transmitting the data converted by the data conversion unit to the information terminal, (Col. 11, lines 3-24).

10. Though Smith teaches a document delivery architecture, Smith does not specifically indicate transmission of specific multimedia types of data, namely, still picture data, wherein the specifications of the information terminal include information of at least one selected from a number of pixels, a tone, a compression ratio, a compression method, a number of reproducible pictures, and a storage capacity, (per pending Claims 28, 31, 34, 40, 43 & 46); moving picture data, wherein the specifications of the information terminal include information of at least one selected from a number of pixels, a tone, a compression ratio, a compression method, a reproduction time and a storage capacity, (per pending Claims 29, 32, 35, 41, 44 & 47); and audio data, wherein the specifications of the information terminal include information of at least one selected from a sampling rate, a frequency band, a compression ratio, a compression method, a reproduction time, and a storage capacity, (per pending Claims 30, 33, 36, 42, 45 & 48).

11. Shaffer discloses a data distribution system wherein the capabilities of the target device are considered in order to determine if a conversion is required, (Shaffer – Abstract), and which system supports multimedia applications, (Shaffer - Col. 5, lines 51-64). It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to combine the teachings of Smith and Shaffer, the motivation for which is found within Shaffer, noting a need for a messaging method and system that provides for an efficient and reliable exchange of attached files in a multi-

application environment, (Shaffer – Col. 2, lines 25-27). Examiner further notes that specific information such as a number of pixels, a tone, a compression ratio, a compression method, a number of reproducible pictures, a reproduction time, a storage capacity, a sampling rate, and a frequency band would have been obvious to include within a request for data for a particular target device, particularly in view of a system capable of transmitting multimedia data, wherein proper and complete transmission of the same to multiple target devices was desired. Thus, Claims 25, 28-37 & 40-48 are found to be unpatentable over the combined teachings of Shaffer and Smith.

12. Regarding Claims 26, 27, 38 & 39, Smith and Shaffer are relied upon for those teachings disclosed herein. Smith further discloses a data distribution system wherein the information provider apparatus further includes a charge management unit for deciding an amount of charges according to contents of data transmitted to the information terminal and charging an information user, (per pending Claims 3 & 4), (Col. 3, line 67; Col. 4, lines 1-2; Col. 5, lines 1-3; Col. 7, lines 27-32; Col. 1, lines 52-56; & Fig. 11), and wherein the information provider apparatus further includes a client database for storing and managing utilization histories of information users, and the charge management unit decides an amount of charges according to utilization history of an information user, stored in the client database, and contents of data transmitted to the information terminal, and charges the information user, (per pending Claims 5 & 6), (Col. 12, lines 11-22; Col. 15, lines 8-67; & Col. 16, lines 1-59). Examiner notes that charge amount based on utilization history would have been obvious in light of Smith which teaches a billing/transaction association in addition to a transaction log and user

database. Thus, Claims 26, 27, 38 & 39 are found to be unpatentable over the combined teachings of Shaffer and Smith.

### ***Response to Arguments***

13. Applicant's arguments filed 14 December 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "converting the quality of the multimedia information to be transmitted to the information terminal according to the reproduction capability of the information terminal" and "conversion of data to reduce the amount of data") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that both Smith and Shaffer teach a data conversion functionality, as noted herein above. Additionally, Examiner notes that Schaffer specifically teaches file-format conversion in a multimedia environment based on a determination of client resources, (Col. 2, lines 30-67 & Col. 3, lines 1-37).

15. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections



are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner finds that the combined teachings of the references cited herein clearly and obviously encompass Applicant's invention, as claimed, in its entirety, rendering the same unpatentable.

16. Regarding Applicant's argument that the combined references do not teach Applicant's claims as amended, Examiner respectfully disagrees. Applicant's amended claim language simply states that the data is converted to the same data format as the data [requested] by the information terminal. Broadly interpreted, "data format" may be read to encompass any type of data format. As Shaffer clearly teaches the comparing of attachment access requirements to client device capabilities followed by a conversion means, (Col. 2, lines 30-40), Examiner finds that Shaffer clearly and obviously reads upon Applicant's claims, as written. Additionally, Examiner would like to refer Applicant to the well-known means of data conversion and delivery as taught by the Murphy '380 patent and the non-patent literature regarding the Windows Media Player, listed herein below as art not relied upon.

17. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how reconsideration avoids such references or objections, Examiner hereby maintains the original rejection of all claims in their entirety.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent US 6,564,380 B1 to Murphy; and  
Windows Media Player "Features", Microsoft Windows Technologies,  
Microsoft Corporation, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Arrienne M. Lezak  
Examiner  
Art Unit 2143